

REMARKS

Summary of the Amendment

Upon consideration of the instant response, claims 29 - 58 will remain pending.

Summary of the Official Action

In the instant Office Action, the Examiner has rejected claims 29 - 58 over the art of record. By the present amendment and remarks, Applicants submit that the objections and rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

Traversal of Rejection Under 35 U.S.C. § 102(b)

Applicant traverses the rejection of claims 29 - 33, 36 - 49, 51, 52, 55, 57, and 58 under 35 U.S.C. § 102(b) as being anticipated by STOTZ et al. (U.S. Patent No. 5,928,121) [hereinafter "STOTZ"]. The Examiner notes Figure 2; column 3, line 62 - column 4, line 42; and column 5, lines 13 - 20 in support of his assertion. Applicant traverses the Examiner's assertion.

Applicant's independent claim 29 recites, *inter alia*, a guide device, positioned at an axial end of said carrier and *radially between said bearing sleeve and said carrier*, being *structured and arranged to permit both a tilting moving and a movement of said bearing sleeve relative to said carrier substantially in the pressing plane*. Applicant submits that STOTZ fails to disclose at least the above-noted feature of the instant invention.

To anticipate the instant invention, each and every recited feature of Applicant's invention must be shown in the applied art. While STOTZ is directed to an adjustable deflection roll, Applicant submits that this document fails to provide any disclosure with regard to a guide device, as recited in at least independent claim 29.

In this regard, Applicant notes that, while they have reviewed not only the portions noted by the Examiner, but the entire disclosure of STOTZ, they have not found any disclosure of a guide device that is positioned at an axial end of the carrier and positioned radially between the bearing sleeve and the carrier that is structured and arranged *to permit both a tilting moving and a movement of said bearing sleeve relative to said carrier substantially in the pressing plane*. Moreover, Applicant notes that the Examiner has not specifically identified which element(s) of STOTZ are believed to show the guide device recited in Applicant's independent claim 29, nor has the Examiner shown that STOTZ shows each and every recited feature of Applicant's claims.

Because STOTZ fails to show at least the above-noted features of the instant invention, Applicant submits that the Examiner has failed to establish an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 102(b), such that the instant rejection is improper and should be withdrawn.

Further, Applicant submits that claims 30 - 33, 36 - 49, 51, 52, 55, 57, and 58 are allowable at least for the reason that these claims depend from allowable base claims and

because these claims recite additional features that further define the present invention. In particular, Applicant submits that STOTZ fails to anticipate, *inter alia*, said guide device is arranged in at least one of an axially central region of said bearing sleeve and centered relative to said bearing sleeve in an axial direction, as recited in claim 30; said bearing sleeve is radially supported at said carrier transversely to the pressing plane via said guide device, as recited in claim 31; said guide device comprises at least one guide member being rotatably mounted in one of said bearing sleeve and said carrier about an axis perpendicular to the pressing plane, and said at least one guide member being structured and arranged to slide as a follower in a guide provided at one of said carrier or said bearing sleeve and to be displaceably guided essentially parallel to the pressing plane, as recited in claim 32; said at least one guide member comprises at least two follower-like guide members provided on mutually opposite sides of said carrier and each cooperating with a respective guide, as recited in claim 33; said roll jacket is axially fixed to said axial end of said carrier at a drive side via said guide device, as recited in claim 36; said roll jacket is supported radially at a guide side opposite said drive side transversely to the pressing plane via said axial bearing sleeve, and is axially displaceable, as recited in claim 37; said bearing sleeve is radially supported at said carrier via at least two bearing members arranged at mutually opposite carrier sides, and said bearing members are rotatably mounted in one of said bearing sleeve or said carrier for rotation about an axis perpendicular to the pressing plane, as recited in

claim 38; said bearing members cooperate with a counter surface which is formed by a counter plate secured to one of said carrier or said bearing sleeve, as recited in claim 39; at least one piston in cylinder arrangement structured and arranged to act generally in the pressing plane is provided radially between said bearing sleeve and said carrier, as recited in claim 40; said at least one piston in cylinder arrangement is positioned at at least one of a support member side of at least one of said carrier and at an opposite carrier side, as recited in claim 41; said piston in cylinder arrangement is positioned to at least one of relieve said roll jacket from weight forces acting outside a working width of said roll jacket, one of load or relieve a respective jacket end in order to influence a pressing force distribution in a press nip by controlled pressure medium loading, or fix said roll jacket in place in a position raised from a counter roll by shutting off a pressure medium backflow from said piston in cylinder arrangement, as recited in claim 42; said bearing sleeve is positioned in a region of a carrier spigot narrowed with respect to an axially central region of said carrier, as recited in claim 43; a piston in cylinder arrangement is arranged between said narrowed carrier spigot and said bearing sleeve, as recited in claim 44; a piston of a piston in cylinder arrangement structured and arranged to act on said bearing sleeve comprises a relief chamber fed with pressure fluid at a side confronting said bearing sleeve, as recited in claim 45; said relief chamber is fed via at least one capillary, as recited in claim 46; the feeding of said relief chamber takes place via a pressure chamber of said piston in cylinder arrangement and

through said piston, as recited in claim 47; a feeding of said relief chamber takes place from a side of said bearing sleeve, as recited in claim 48; a piston of a piston in cylinder arrangement is arranged to directly contact an inner side of said bearing sleeve, as recited in claim 49; said at least one of said axial end of or said axial continuation of said roll jacket is rotatably mounted at said bearing sleeve by two axially spaced apart bearings, as recited in claim 51; said two axially spaced apart bearings are each formed by a rolling bearing, as recited in claim 52; said at least one of said axial end of or said axial continuation of said roll jacket is located at a drive side is arranged to outwardly radially carry a gear ring structured and arranged to the roll drive, as recited in claim 55; further comprising frames arranged to rotationally fixedly hold said ends of said carrier, as recited in claim 57; and the pressing plane is perpendicular to a roll axis, as recited in claim 58.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the rejection of claims 29 - 33, 36 - 49, 51, 52, 55, 57, and 58 under 35 U.S.C. § 102(b) and indicate that these claims are allowable.

Traversal of Rejection Under 35 U.S.C. § 103(a)

1. Over Stotz

Applicant traverses the rejection of claims 34, 35, 50, 53, 54, and 56 under 35 U.S.C. § 103(a) as being unpatentable over STOTZ. The Examiner asserts that, while STOTZ fails to show the configuration of the guide member, the specifically recited arrangement would

have been an obvious design expedient. Applicant traverses the Examiner's assertions.

Applicant notes that, in addition to failing to show any element or elements that corresponds to the recited guide device of at least independent claim 29, the Examiner has failed to show any teaching or suggestion for utilizing such a guide device in the STOTZ apparatus. Because the applied art fails to provide any teaching or suggestion of the recited guide device, Applicant submits that STOTZ fails to render unpatentable at least independent claim 29.

Further, while the Examiner has provided sweeping conclusory statements that the configuration of the guide device (which is neither taught nor suggested by STOTZ) would have been an obvious design expedient, the record fails to provide any documentary evidence to support the Examiner's position. Moreover, Applicant submits that, because STOTZ does not even arguably show the guide device at issue, this document cannot render obvious the features recited in the claims.

Applicant also notes that, because the guide device is not shown by STOTZ, this document fails to provide any disclosure of various requirements for the guide device and what considerations must be observed when utilizing such a device with a roll such as STOTZ. Because no such disclosure is provided in STOTZ, Applicant submits that the art of record cannot even arguably suggest to one ordinarily skilled in the art a design expedient for the guide device of the instant invention.

Further, Applicant submits that claims 34, 35, 50, 53, 54, and 56 are allowable at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper modification of STOTZ teaches or suggests, *inter alia*, said guide, arranged to cooperate with said at least one guide member, is formed at a counter plate secured to said one of said carrier or said bearing sleeve, as recited in claim 34; said guide member comprises a flange with a collar, as recited in claim 35; a piston of a piston in cylinder arrangement is arranged to contact a shallow side of an intermediate member arranged between said carrier and said bearing sleeve, as recited in claim 50; said at least one supporting member comprises a plurality of supporting members arranged to form a single-zone roll, such that said plurality of supporting members are loaded with a same pressure, as recited in claim 53; said at least one supporting member comprises a plurality of supporting members arranged to form a multi-zone roll, such that at least some of said plurality of supporting members are loaded with different pressures, as recited in claim 54; and axial centers of at least one of said gear ring, said bearing arrangement, said guide device, and a piston in cylinder arrangement lie substantially in a common plane perpendicular to a roll axis, as recited in claim 56.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the rejection of claims 34, 35, 50, 53, 54, and 56 under 35 U.S.C. § 103(a) and indicate that these

claims are allowable.

2. Over DE '519

Applicant traverses the rejection of claims 29 - 33, 57, and 58 under 35 U.S.C. § 103(a) as being unpatentable over German Patent Application No. 197 23 519 [hereinafter "DE '519"]. The Examiner asserts that DE '519 is applied for the reasons set forth in the rejection of claims 1 - 5 of the parent application. The Examiner further asserts that, since this document has not been translated and no arguments have been made as to the validity of the rejection, full faith and credit is given to the previous Examiner. Applicant traverses the Examiner's assertions.

Applicant notes that the "parent application" referred to by the Examiner is a counterpart application filed in Germany, and the "rejection" is a search report. Accordingly, Applicant notes that a search report issued from the German Patent Office is a listing of documents found by the German Examiner to be pertinent to the claims of the German application, and certainly does not constitute a "rejection" of claims filed in the U.S. Patent and Trademark Office to which full faith and credit is given.

Moreover, Applicant notes that Office Action in counterpart applications, which are conducted in foreign Patent Offices are not binding in U.S. patent prosecution. Even assuming, *arguendo*, that the foreign prosecution were binding on the prosecution in the U.S. Patent and Trademark Office, which certainly it is not, Applicant notes that the Examiner is

blindly relying on the German Examiner's finding without ascertaining whether the claims examined during the German procedure are identical to the claims pending in the instant application.

Because the Examiner of the instant application does not know the scope of the claims pending in Germany, does not understand the disclosure of the document cited by the German Examiner, and does not considered the merit of the claims under U.S. patent law, Applicant submits that the instant rejection must be withdrawn. Further, Applicant submits that the Official Action must provide an examination of the claims in accordance with U.S. Patent laws, and, if the Examiner cannot understand the document, she should obtain an English language translation of the document so that she can make a determination of whether the claims pending in the U.S. application are novel and non-obvious under U.S. patent law over the documents made of record in the German procedure.

Because the Examiner has shown no teaching or suggestion in the applied document that renders unpatentable any feature of the instant invention, Applicant submits that the asserted rejection of the claims is improper and must be withdrawn.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the rejection of claims 29 - 33, 57, and 58 under 35 U.S.C. § 103(a) and indicate that these claims are allowable.

3. Over DE '022

Applicant traverses the rejection of claims 29 - 33, 57, and 58 under 35 U.S.C. § 103(a) as being unpatentable over German Patent Application No. 42 42 022 [hereinafter "DE '022"]. The Examiner asserts that this document is applied for the reasons set forth in the German Search Report. The Examiner asserts that DE '022 is applied for the reasons set forth in the rejection of claims 1 - 5 of the parent application. The Examiner further asserts that, since this document has not been translated and no arguments have been made as to the validity of the rejection, full faith and credit is given to the previous Examiner. Applicant traverses the Examiner's assertions.

As discussed above, the "parent application" referred to by the Examiner is a counterpart application filed in Germany, and the "rejection" is a search report. Accordingly, Applicant again notes that the search report issued from the German Patent Office certainly does not constitute a "rejection" of claims filed in the U.S. Patent and Trademark Office to which full faith and credit is given.

Moreover, Applicant notes that Office Action in counterpart applications, which are conducted in foreign Patent Offices are not binding in U.S. patent prosecution. Even assuming, *arguendo*, that the foreign prosecution were binding on the prosecution in the U.S. Patent and Trademark Office, which certainly it is not, Applicant notes that the Examiner is blindly relying on the German Examiner's finding without ascertaining whether the claims examined during the German procedure are identical to the claims pending in the instant

application.

Because the Examiner of the instant application does not know the scope of the claims pending in Germany, does not understand the disclosure of the document cited by the German Examiner, and does not considered the merit of the claims under U.S. patent law, Applicant submits that the instant rejection must be withdrawn. Further, Applicant submits that the Official Action must provide an examination of the claims in accordance with U.S. Patent laws, and, if the Examiner cannot understand the document, she should obtain an English language translation of the document so that she can make a determination of whether the claims pending in the U.S. application are novel and non-obvious under U.S. patent law over the documents made of record in the German procedure.

Because the Examiner has shown no teaching or suggestion in the applied document that renders unpatentable any feature of the instant invention, Applicant submits that the asserted rejection of the claims is improper and must be withdrawn.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the rejection of claims 29 - 33, 57, and 58 under 35 U.S.C. § 103(a) and indicate that these claims are allowable.

4. Over DE 71 44 301

Applicant traverses the rejection of claim 39 under 35 U.S.C. § 103(a) as being unpatentable over German Gebrauchsmuster No. 71 44 301 [hereinafter "DE '301"]. The

Examiner asserts that this document is applied for the reasons set forth in the German Search Report. The Examiner asserts that DE '301 is applied for the reasons set forth in the rejection of claim 11 of the parent application. The Examiner further asserts that, since this document has not been translated and no arguments have been made as to the validity of the rejection, full faith and credit is given to the previous Examiner. Applicant traverses the Examiner's assertions.

As discussed above, the "parent application" referred to by the Examiner is a counterpart application filed in Germany, and the "rejection" is a search report. Accordingly, Applicant again notes that the search report issued from the German Patent Office certainly does not constitute a "rejection" of claims filed in the U.S. Patent and Trademark Office to which full faith and credit is given.

Moreover, Applicant notes that Office Action in counterpart applications, which are conducted in foreign Patent Offices are not binding in U.S. patent prosecution. Even assuming, *arguendo*, that the foreign prosecution were binding on the prosecution in the U.S. Patent and Trademark Office, which certainly it is not, Applicant notes that the Examiner is blindly relying on the German Examiner's finding without ascertaining whether the claims examined during the German procedure are identical to the claims pending in the instant application.

Because the Examiner of the instant application does not know the scope of the claims

pending in Germany, does not understand the disclosure of the document cited by the German Examiner, and does not considered the merit of the claims under U.S. patent law, Applicant submits that the instant rejection must be withdrawn. Further, Applicant submits that the Official Action must provide an examination of the claims in accordance with U.S. Patent laws, and, if the Examiner cannot understand the document, she should obtain an English language translation of the document so that she can make a determination of whether the claims pending in the U.S. application are novel and non-obvious under U.S. patent law over the documents made of record in the German procedure.

Because the Examiner has shown no teaching or suggestion in the applied document that renders unpatentable any feature of the instant invention, Applicant submits that the asserted rejection of the claims is improper and must be withdrawn.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the rejection of claim 39 under 35 U.S.C. § 103(a) and indicate that these claims are allowable.

5. Over AT '927

Applicant traverses the rejection of claims 29 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Austrian Patent No. 351,927 [hereinafter "AT '927"]. The Examiner asserts that this document is applied for the reasons set forth in the German Search Report. The Examiner asserts that this document is applied for the reasons set forth in the German Search Report. The Examiner asserts that AT '927 is applied for the reasons set

forth in the rejection of claims 1 and 10 of the parent application. The Examiner further asserts that, since this document has not been translated and no arguments have been made as to the validity of the rejection, full faith and credit is given to the previous Examiner. Applicant traverses the Examiner's assertions.

As discussed above, the "parent application" referred to by the Examiner is a counterpart application filed in Germany, and the "rejection" is a search report. Accordingly, Applicant again notes that the search report issued from the German Patent Office certainly does not constitute a "rejection" of claims filed in the U.S. Patent and Trademark Office to which full faith and credit is given.

Moreover, Applicant notes that Office Action in counterpart applications, which are conducted in foreign Patent Offices are not binding in U.S. patent prosecution. Even assuming, *arguendo*, that the foreign prosecution were binding on the prosecution in the U.S. Patent and Trademark Office, which certainly it is not, Applicant notes that the Examiner is blindly relying on the German Examiner's finding without ascertaining whether the claims examined during the German procedure are identical to the claims pending in the instant application.

Because the Examiner of the instant application does not know the scope of the claims pending in Germany, does not understand the disclosure of the document cited by the German Examiner, and does not considered the merit of the claims under U.S. patent law,

Applicant submits that the instant rejection must be withdrawn. Further, Applicant submits that the Official Action must provide an examination of the claims in accordance with U.S. Patent laws, and, if the Examiner cannot understand the document, she should obtain an English language translation of the document so that she can make a determination of whether the claims pending in the U.S. application are novel and non-obvious under U.S. patent law over the documents made of record in the German procedure.

Because the Examiner has shown no teaching or suggestion in the applied document that renders unpatentable any feature of the instant invention, Applicant submits that the asserted rejection of the claims is improper and must be withdrawn.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the rejection of claims 29 and 38 under 35 U.S.C. § 103(a) and indicate that these claims are allowable.

6. Over EP '912

Applicant traverses the rejection of claims 29 - 58 under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. 0 787 912 [hereinafter "EP '912"]. The Examiner asserts that this document is applied for the reasons set forth in the German Search Report. The Examiner asserts that this document is applied for the reasons set forth in the German Search Report. The Examiner asserts that EP '912 is applied for the reasons set forth in the rejection of claims 1, 6 - 9, 12, 19, 21, and 23 - 27 of the parent application. The Examiner

further asserts that, since this document has not been translated and no arguments have been made as to the validity of the rejection, full faith and credit is given to the previous Examiner. Applicant traverses the Examiner's assertions.

As discussed above, the "parent application" referred to by the Examiner is a counterpart application filed in Germany, and the "rejection" is a search report. Accordingly, Applicant again notes that the search report issued from the German Patent Office certainly does not constitute a "rejection" of claims filed in the U.S. Patent and Trademark Office to which full faith and credit is given.

Moreover, Applicant notes that Office Action in counterpart applications, which are conducted in foreign Patent Offices are not binding in U.S. patent prosecution. Even assuming, *arguendo*, that the foreign prosecution were binding on the prosecution in the U.S. Patent and Trademark Office, which certainly it is not, Applicant notes that the Examiner is blindly relying on the German Examiner's finding without ascertaining whether the claims examined during the German procedure are identical to the claims pending in the instant application.

Because the Examiner of the instant application does not know the scope of the claims pending in Germany, does not understand the disclosure of the document cited by the German Examiner, and does not considered the merit of the claims under U.S. patent law, Applicant submits that the instant rejection must be withdrawn. Further, Applicant submits

that the Official Action must provide an examination of the claims in accordance with U.S. Patent laws, and, if the Examiner cannot understand the document, she should obtain an English language translation of the document so that she can make a determination of whether the claims pending in the U.S. application are novel and non-obvious under U.S. patent law over the documents made of record in the German procedure.

Because the Examiner has shown no teaching or suggestion in the applied document that renders unpatentable any feature of the instant invention, Applicant submits that the asserted rejection of the claims is improper and must be withdrawn.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the rejection of claims 29 - 58 under 35 U.S.C. § 103(a) and indicate that these claims are allowable.

7. Over Stotz

Applicant traverses the rejection of claims 34 - 58 under 35 U.S.C. § 103(a) as being unpatentable over STOTZ.

Applicant notes that, as discussed above, the Examiner has rejected claims 34, 35, 50, 53, 54, and 56 under 35 U.S.C. § 103(a) over STOTZ. In the rejection, the Examiner provided comments on the art in relation to the features of Applicant's claims. However, in the instant rejection, the Examiner has not pointed to any teachings in STOTZ that assertedly renders obvious any feature of the invention.

Accordingly, Applicant submits that the Examiner has not set forth a prima facie case of obviousness with regard to claims 36 - 49, 51, 52, 55, 57, and 58, such that these rejections are improper and must be withdrawn, and that the deficiencies of the Examiner's assertions with regard to claims 34, 35, 50, 53, 54, and 56 have been fully discussed above.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the rejection of claims 29 - 58 under 35 U.S.C. § 103(a) and indicate the claims are allowable.

Application is Allowable

Thus, Applicants respectfully submit that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 102 and 103, and respectfully request the Examiner to indicate allowance of each and every pending claim of the present invention.

Authorization to Charge Deposit Account

The undersigned authorizes the charging of any necessary fees, including any extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, to Deposit Account No. 19 - 0089 in order to maintain pendency of this application.

CONCLUSION

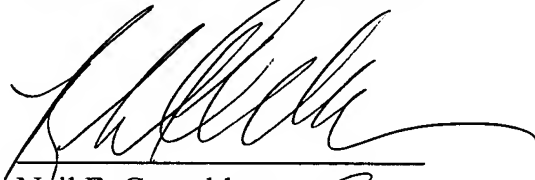
In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicants'

invention, as recited in each of claims 29 - 58. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully submitted,
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